

REMARKS

Claims 28-41 and 43-55 are pending. By this Substitute Amendment, the drawings are corrected as attached, and the title, the specification and claims 28-40, 43 and 45-55 are amended. No new matter is added by any of these amendments.

Applicant appreciates the courtesies extended to Applicant's representative by Examiner Fischer during the April 24, 2003 personal interview. The points discussed during the interview are incorporated in the remarks below and constitute Applicant's record of the interview.

Reconsideration based on the following remarks is respectfully requested.

**I. The Amendment Complies with Final Rule Requirements**

The Notice of Non-Compliant Amendment declared the July 11, 2003 Amendment as non-compliant under 37 CFR §1.121 Final Rules amended June 30, 2003 (see 68 *Fed. Reg.* 38611) and adopted effective July 30, 2003. The previously cancelled claims 1-27 are listed. Accordingly, Applicant respectfully requests entry of this Amendment.

Because these amendments are resubmitted within the one-month period from the mailing of the Notice, no further Petition for Extension of Time is required.

**II. The Drawings Satisfy All Formal Requirements**

The Office Action objects to the drawings based on informalities. Figure 8 is corrected and Figures 9 and 10 are added as attached. The changes to Fig. 8 are shown in strikethrough for deletions and underlining for additions. The specification has been amended to further obviate the objection. Formal Drawings will be filed upon Notice of Allowance. Withdrawal of the objection to the drawings is respectfully requested.

**III. The Claims Satisfy All Formal Requirements**

The Office Action objects to the claims based on informalities as related to the drawings. Claims 28-40, 43 and 45-55 have been amended to obviate the objection.

The Office Action asserts that the subject matter of claims 29-41 and 43-55 are not shown in the figures under 37 CFR §1.83. This objection is respectfully traversed.

In particular, the step of recording and registering the additional third data with purchase information or data specific information in claims 29, 31, 33, 38, 40, 43, 44 and 46-51 is shown in Fig. 8 as steps 205 and 206. The step of determining whether or not the purchase meets the requirement in claims 36, 37, 39 and 45 is shown in Fig. 7 as step 102 and in Fig. 8 as step 202.

The step of recording the accounting information that includes each of the deposited account E2, paid amount E3, and balance E4 in claims 30 and 52 is shown in Fig. 8 as steps 205 and 206, and in Figs. 6 and 9 as elements of Z3.

The step of recording the purchase information that includes title A1, price A2, shop information A3 and date-and-time A4 in claims 32 and 53 is shown in Fig. 8 as steps 205 and 206, and in Figs. 5 and 10 as elements of recorded segment Z2. The step of recording the purchase information that includes title A1, purchase date E1, deposited amount E2, paid amount E3, balance E4, and shop information E5 in claims 35 and 54 is shown in Fig. 8 as steps 205 and 206, and in Figs. 5, 6 and 10 as elements recorded segments Z2 and Z3.

The step of using a record medium having only a recording function is shown in Fig. 1 as a floppy disk 13, and further described in the specification at page 25, lines 27-33. The step of using a data processing apparatus installed on the purchaser's side in claim 55 is shown in Fig. 2 as a data processing apparatus 26. Withdrawal of the claim objection is respectfully requested.

#### **IV. Claims 28-41 and 43-55 Satisfy Statutory Subject Matter Requirements**

The Office Action rejects claims 28-41 and 43-55 under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Office Action requests clarification regarding the statutory category of the claims. In response, Applicant submits that the subject matter of claims 28-41 and 43-55 is drawn to

one or more methods rather than a product-by-process. Withdrawal of the subject matter rejection is respectfully requested.

**V. The Claims Satisfy the Requirements under 35 U.S.C. §112, second paragraph**

The Office Action rejects claims 28-41 and 43-55 under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is respectfully traversed. Claims 28-40, 43 and 45-55 have been amended to obviate this rejection in view of the Examiner's helpful comments.

The Office Action requests clarification of "third data", in relation to "first data" and "second data", as recited in the claims. In response, Applicant submits that the first data represent a recordable good (as understood under the Uniform Commercial Code) available for purchase, as described in the specification. Further, Applicant submits that the second data represent identification information of the purchaser, and third data include purchase information, both as described in the specification and claims.

Also, Applicant submits that the third data can be distinguished between purchaser third data recorded on the purchaser's rewritable record medium, registered third data that are registered on a data providing system, and additional third data that represent the purchase information for the immediate transaction of the first data. While the purchaser third data and the registered third data would ostensibly contain identical values for third data to be matched, they are distinct by virtue of their separate storage locations and access means.

Applicant submits that the accounting information and purchase information, further defined in several dependent claims, include respective lists of conjunctively identified information. Applicant further submits that the preamble in independent claim 28 provides context in which the steps operate in relation to identified apparatuses used to practice the method claimed. Hence, the preamble in claim 28 should be given patentable weight in interpreting the claims. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

**VI. Claims 28-41 and 43-55 Define Patentable Subject Matter**

The Office Action rejects claims 28-41 and 43-45 under 35 U.S.C. §102(e) over U.S. Patent 6,129,274 to Suzuki. The Office Action further rejects claims 28-41 and 43-45 under 35 U.S.C. §103(a) over Suzuki. This rejection is respectfully traversed.

Suzuki does not teach or suggest a data providing method for providing a purchaser with first data for which to make a purchase request from a data providing system having a data delivery portion for delivering the first data to the purchaser and a data intermediate portion connected with the data delivery portion via a communication line for intermediately between the data delivery portion and the purchaser, the purchaser having a purchaser rewritable record medium for recording the first data, second data and third data, the second data representing an identification information of the purchaser, the third data including purchase information for purchasing the first data, recorded on the purchaser rewritable record medium and registered in the data providing system as registered third data, the method including, *inter alia*, retrieving the registered third data from the data providing system based on the second data recorded in the purchaser rewritable record medium, when the purchaser makes the purchase request of the first data, performing an accounting operation that provides the purchaser with the first data when the registered third data are matched with the purchaser third data, the purchaser third data including additional third data that represent the purchase information for purchasing the first data, recording in the purchaser rewritable record medium the first data and the additional third data, after the accounting operation is performed, and registering in the data providing system the additional third data, after the accounting operation is performed, as recited in claim 28.

Instead, Suzuki discloses a system for updating transaction history without intervention of a store platform computer. In particular, Suzuki teaches use of a customer-maintained machine-readable smart card 10 for receiving and recording data from a point-of-sale terminal 12 or stand-alone terminal 30 to update purchase transactions of general

merchandise. The data are recorded in a static information storage area 70 of the smart card  
10. See col. 8, line 54 – col. 10, line 36 and Figs. 1-2 of Suzuki.

By disclosing a smart card 10 having an integrated circuit (IC), Suzuki teaches away from Applicant's claimed feature of recording data on a purchaser rewritable record medium. Further, because Suzuki neither teaches nor suggests recording the first data (*i.e.*, the recordable purchased good) in the purchaser rewritable record medium, Suzuki fails to anticipate at least this feature in Applicant's claim 28. Rather, Suzuki provides a system for awarding coupons to a customer. Because this purpose of Suzuki has no relation to recording the first data (*e.g.*, uploading purchased software), Suzuki provides no motivation to modify teachings to achieve Applicant's claimed features. Hence, Applicant's claimed features are also not obvious in view of Suzuki. In addition, Suzuki fails to specify a sequential order or matching condition for updating purchase transactions. The Office Action has not established that Suzuki teaches every feature of Applicant's claims, nor shown a sufficient motivation to modify, or a *prima facie* case of obviousness. Thus Suzuki neither anticipates nor renders obvious at least these features in Applicant's claim 28. These arguments apply by extension to claims 29-41 and 43-55.

For at least these reasons, Applicant respectfully asserts that the independent claim is now patentable over the applied reference. The dependent claims are likewise patentable over the applied reference for at least the reasons discussed as well as for the additional features they recite. Consequently, all the claims are in condition for allowance. Thus, Applicant respectfully requests that the rejections under 35 U.S.C. §§102 and 103 be withdrawn.

## **VII. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:GWT/gwt

Attachment:

Corrected Figs. 8-10

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